PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 019281-000800US

I hereby certify that this correspondence is being filed via EFS-Web with the United States Patent and Trademark Office, Attn: Mail Stop AF, on ___June 10, 2009_____ . TOWNSEND and TOWNSEND and CREW LLP Signature _____/Joni E. Peterson/_____ Typed of printed name _____Joni E. Peterson_____	Application Number 09/687,157	Filed October 12, 2000
	First Named Inventor John J. Sie	
	Art Unit 2191	Examiner Phillip H. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
    See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
    (Form PTO/SB/96)

☒ attorney or agent of record.
    Registration number __52,471_____ .

☐ attorney or agent acting under 37 CFR 1.34.

    Registration number if acting under 37 CFR 1.34. _____

/William J. Daley/
_____
Signature

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Typed or printed name

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_____
Telephone number

June 10, 2009
_____
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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TOWNSEND and TOWNSEND and CREW LLP

By: _____ /Joni E. Peterson/ _____
            Joni E. Peterson

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

    John J. Sie et al.

Application No.: 09/687,157

Filed: October 12, 2000

For: DISTRIBUTING AND STORING
CONTENT TO A USER'S LOCATION

Customer No.: 20350

Confirmation No.: 8624

Examiner: Phillip H. Nguyen

Art Unit: 2191

STATEMENT OF REASONS IN
SUPPORT OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW

Via EFS-Web
Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

        This statement is submitted in support of the Pre-Appeal Brief Request for Review, that is submitted herewith. The Applicant respectfully requests review of the final rejection mailed by the U.S. Patent Office for the above-identified application on February 10, 2009 ("the Final Office Action").

        A Notice of Appeal is being filed concurrently herewith.

1. Status of Claims

Claims 1-2, 4-5, 7-8, 10-15, 17-18, and 20-24 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,606,359 to Youden et al. (hereinafter "Youden")

2. Reasons for Requesting Review

As noted above, the Office action has rejected claims 1-2, 4-5, 7-8, 10-15, 17-18, and 20-24 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,606,359 to Youden et al. (hereinafter "Youden"). The Applicant respectfully submits the following arguments pointing out significant differences between claims 1-2, 4-5, 7-8, 10-15, 17-18, and 20-24 submitted by the Applicants and Youden.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully argue that Youden fails to disclose each and every claimed element. For example, Youden fails to disclose, either expressly or inherently, storing content at a user location before the user specifically requests the content.

Youden is directed to "a video server for providing Video-On-Demand." Under Youden a "data storage system comprises a large capacity archival storage element with a relatively slow data access and transmission rate and a plurality of smaller capacity disk drive arrays with higher data access and transmission rates than the archival storage element." (Col. 2, lines 47-51) "In typical use, video data in the archival storage element must be transcribed to the disk drive arrays before the video data is accessible to users." (Col. 2, lines 54-56) That is, Youden describes pre-striping or caching content from an archive on a disk array.

However, Youden does not disclose, expressly or inherently, storing content at a user location before the user specifically requests the content. Rather, Youden describes providing content to a user's location, i.e., a user's STB, from the disk array only after the content has been selected or requested. See for example, col. 3, lines 10-16 and 42-51. As noted in the Office Action (page 3) "a subset of video from the distributor has been pre-striped (pre-stored) at the disk array." However, the Applicants contend that Youden does not disclose the disk array being located at a user location and such a reading of Youden would not be reasonable. Rather, such a disk array would be part of the content distributor's system(s) and would not be at a user location, e.g., a user's residence (see claims 23 and 24) The Office Action also notes that "a user, through his or her STB makes a request which is transmitted over one of the communication channels in distribution network 20." The Applicants note that such a transmission, i.e., of the distribution network, would not be required if the content (i.e., the disk array) was at the user's location. Furthermore, the Applicants respectfully point out that such a transmission does not occur until after the user specifically requests the content. Thus, Youden does not disclose, expressly or inherently, storing content at a user location before the user specifically requests the content. Rather, Youden describes pre-striping or caching content on a disk array and then providing the content from the disk array to a user location, i.e., the users STB, only after it has been requested by the user.

In response to these arguments, the final Office Action contends that the client node 30 of FIG. 1 of Youden can comprise a video server. (final Office Action page 2 citing Youden col. 5, lines 14-19) However, the final Office Action does not suggest and Youden does not describe an implementation in which the video server 10 between the application servers 40 and distribution network 20 is not used in distributing content to the client node 30. Thus, to any extent that the client node 30 of FIG. 1 of Youden may be implemented as or with a video server, it would be in addition to, not instead of, video server 10. Furthermore, regardless of whether the client node of Youden is an STB, video server, or other component, the Applicants respectfully maintain that Youden does not disclose, expressly or inherently, storing content at the client node before the user specifically requests the content. Rather, Youden describes pre-

striping or caching content at video server 10 of FIG. 1 and then providing the content from video server to client node 30 only after it has been requested by the user.

Claim 1, upon which claims 2, 4-7, and 21-23 depend, is directed to a method for distributing content sent by a content distributor to a user location. Claim 14, upon which claims 15, and 17-20 depend, is directed to a distribution program product having code for distributing content sent by a content distributor to a user location. Both claim 1 and claim 14 recite in part "receiving a command from the content distributor to store the content at the user location before a user specifically requests the content, wherein the content comprises a subset of content available from the content distributor, the subset associated with a premium subscription service, and wherein the content comprises at least one of a video program or an audio program." Youden does not disclose, expressly or inherently, storing content at a user location before the user specifically requests the content. Rather, Youden describes pre-striping or caching content on a disk array and then providing the content from the disk array to a user location, i.e., the client node, only after it has been requested by the user. For at least these reasons, the rejection is improper and claims 1-2, 4-7, 14-15, and 17-22 should be allowed.

Claim 8, upon which claims 9-13 and 24 depend, is directed to a method for distributing content sent by a content distributor to a user location and recites in part "determining a subset of content from a larger set of content available from the content distributor, wherein the subset of content is associated with a premium subscription service", "commanding the user location to store the content from the content distributor without a user associated with the user location specifically requesting the content", and "sending the content to the user location for storage before a user specifically requests the, wherein the content comprises at least one of a video program or an audio program." Youden does not describe, expressly or inherently, storing content at a user location before the user specifically requests the content. Rather, Youden describes pre-striping or caching content on a disk array and then providing the content from the disk array to a user location, i.e., the client node, only after it has been requested by the user. For at least these reasons, the Applicants maintain that the rejection is improper and should be withdrawn.

Respectfully submitted,

Date: _____June 10, 2009_____   _____/William J. Daley/_____
                                                   William J. Daley
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